

REMARKS

After entry of this amendment, claims 1-6 will be all the claims pending in the application. Claims 6 and 7 are new. Support for new claim 6 may be found in the specification, e.g., at page 11, lines 17-23. Support for new claim 7 may be found in the specification, e.g., at page 5, lines 20-22 take together with page 17, lines 2-5.

Entry of the above amendment is respectfully requested.

Claim Rejections -35 U.S.C § 103

In response to the rejection of claims 1-5 over JP 2001-260549 (hereinafter “JP ‘549”) machine translation in view of JP 11-189762 (hereinafter “JP ‘762”) machine translation, Applicant has the following additional comments in addition to the comments of record.

With respect to the Examiner’s indication in the Advisory Action that Applicant’s showing of unexpected results is not commensurate in scope with the claimed invention because the claims do not require visual definition of image and bending resistance, Applicant submits that unexpected advantages do not have to be claimed to be relevant to patentability; in fact, they do not even need to be disclosed in the application, as set forth in *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), cited in MPEP 716.02(f). Further, with regard to the Examiner’s indication that the data of the visual definition of image is not quantitative, Applicant submits that there is no requirement in the MPEP that proffered data showing unexpected results must be quantitative.

Further, Applicant submits that a *prima facie* case of obviousness has not been made because there is no motivation to combine the cited references to arrive at the present invention. JP ‘549 is different in constitution of the invention and effect of the invention, compared with JP ‘762. JP ‘549 discloses that the effects of the invention are a superior surface hardness and a superior scratch resistance because of the hard coat layer, and further, when an ultraviolet

absorbent is mixed in the hard coat layer, the effect of the invention is to suppress change in color of the hard coat layer. On the other hand, JP '762 discloses an adhesive sheet substrate comprising a urethane acrylate based composition which is suitable for both energy saving measures and resistance against volatile organic compound.

Applicant submits that because JP '549 is not concerned with the effects of energy saving measures and resistance against volatile organic compound as disclosed by JP '762, one skilled in the art would not be motivated to combine the cited references to arrive at the present invention.

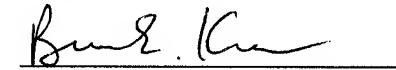
Further, with respect to method claim 5, Applicant submits that the cited references do not teach or suggest the process film as recited in the claim.

Finally, with respect to new claims 6 and 7, Applicant submits that the requirements set forth therein further distinguish the claimed invention. In regard to claim 7 in particular, it is noted that the weight-average molecular weight of the urethane acrylate A in JP '762 is preferably 1,000-10,000, and thus even if one were to use the teachings of JP '762 in JP '549, one would not have used a non-preferred embodiment, and thus one would not have arrived at the invention of claim 7.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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